Appeal Brief

#7

4/22/02

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R. Neil Sudol

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

APPLICANT(S) : Peter J. WILK

SERIAL NO. : 09/661,520

FILED : 09/13/00

FOR : Sea Shell Novelty Item

GROUP ART UNIT : 3712

EXAMINER : K. Nguyen

Commissioner for Patents
Washington, D.C. 20231

BRIEF ON APPEAL

1. REAL PARTY IN INTEREST

The real party of interest in the present application is appellant's company Wilk Patent

2. RELATED APPEALS AND INTERFERENCES

On information and belief, there are no cases currently on appeal before the Board which may have a bearing on the Board's decision in the instant Appeal.

3. STATUS OF CLAIMS

Claims 1-18 are pending in the application. No claims have been canceled. Claims 1, 7, 10, 13, 14, 17, and 18 are the only independent claims. All of the pending claims stand rejected under 35 U.S.C. § 103(a) as being unpatentable over prior art.

The appealed claims are set forth in Appendix A.

4. STATUS OF AMENDMENTS

No Amendments were filed after the final Office Action. All Amendments have been entered.

5. SUMMARY OF THE INVENTION

As set forth in apparatus claim 1, a novelty or entertainment device comprises a housing in the form of a sea shell (page 2, line 1; page 5, lines 10-11), a sound reproduction system mounted to the housing so as to remain hidden from casual visual inspection of the housing (page 2, lines 1-2; page 5, lines 18-19), and a switch mounted to the housing and operatively connected to the sound reproduction system for activating same after and only after a lifting of the housing

[illegible] method claim 14, a novelty or

page 5, lines 10-11) and reproducing a predetermined sound after and only after a removal of the housing from a stationary storage position towards an ear of a user, so that the reproduced sound may be perceived by the user.

As set forth in apparatus claim 10, the switch is mounted to the housing and is operatively connected to the sound reproduction system for activating the same in response to a lifting of the housing to an ear of a user, the switch including means for selectively activating the sound reproduction system only after the housing has been placed proximate to the ear of the user (page 5, lines 15-17; page 6, lines 19-21; page 7, lines 9-11). As set forth in related method claim 7, a novelty or entertainment method comprises providing a housing in the form of a sea shell (page 4, line 15) and, in response to a removal of the housing from a stationary storage position towards an ear of a user, reproducing a predetermined sound so that the reproduced sound may be perceived by the user upon and only upon an approximation of a mouth of the housing to the ear of the user (page 4, lines 15-18; page 8, lines 3-4, lines 11-12).

As set forth in apparatus claim 13, the sound reproduction system (page 2, lines 1-2; page 5, lines 18-19) includes a memory (page 5, line 20) storing a plurality of different sound bites and means for accessing the different sound bites on successive activations of the sound reproduction system by the switch. (Page 2, last line, through page 3, line 8; page 8, lines 1-9.) As set forth in related method claim 17, a first predetermined sound is reproduced in response to a first removal of the housing from a stationary storage position towards an ear of a user, so that the reproduced sound may be perceived by the user, and subsequently a second predetermined sound substantially different from the first predetermined sound is reproduced, in response to a second

reproduced second predetermined sound may be perceived by the user. (Page 1, last line, through page 3, line 8; page 8, lines 1-9.)

As recited in claim 18, the sound reproduction system (page 2, lines 1-2; page 5, lines 18-19) includes a memory (page 5, line 20) storing a signal corresponding to a predetermined sound substantially different from sound generated in nature upon placement of a sea shell next to an ear. (Page 2, lines 9-22; page 3, lines 9-19; page 5, lines 15-17 and 20-22; page 7, lines 12-23.)

A stored sound may be a verbal message. (Page 2, lines 14-19; page 3, lines 17-19; page 4, line 18; page 7, lines 16-20.)

6. ISSUES

Whether claims 1-5, 7-12, and 14-16 are properly rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,216,516 to Saitoh.

Whether claims 6, 13, 17 and 18 are properly stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Saitoh in view of U.S. Patent No. 4,923,428 to Curran.

7. GROUPING OF CLAIMS

With respect to the issues under 35 U.S.C. § 103(a), the following claims groupings are believed to be proper.

Independent claims 1 and 14 and dependent claims 2-5 and 16 are deemed to stand or fall together, separately from all of the other claims on appeal in the application, and particularly separately from independent claims 7, 10, 13, 17, and 18. Claim 1 particularly recites a switch

same after and only after a lifting of the housing to an ear of a user. None of the other independent claims recite a switch with a structure inducing activation of a sound reproduction system after and only after a lifting of a housing to an ear of a user. With reference to claim 14, none of the other independent claims set forth the reproducing of a predetermined sound, so that the reproduced sound may be perceived by the user, after and only after a removal of the housing from a stationary storage position towards an ear of a user.

Dependent claim 6 is deemed to stand or fall separately from all of the other claims on appeal in the application. Although claim 6 specifically recites subject matter found in claim 13, claim 6 also incorporates recitations from claim 1 which are not found in claim 13.

Dependent claim 15 is deemed to stand or fall separately from all of the other claims on appeal in the application. Although claims 8 and 15 specifically recite similar subject matter, they are dependent from respective independent claims which contain different subject matter.

Independent claims 7 and 10 and dependent claims 11 and 12 are deemed to stand or fall together, separately from all of the other claims on appeal in the application, and particularly separately from independent claims 1, 13, 14, 17, and 18. Claims 7 and 10 are respectively method and apparatus claims which are directed in part to the reproduction of a stored sound only after a housing has been placed proximate to the ear of the user. None of the other

matter but are dependent from independent claims which contain different subject matter.

Dependent claim 9 is deemed to stand or fall separately from all of the other claims on appeal in the application. Nothing in the prior art relied on by the Examiner teaches or suggests the subject matter specifically recited in claim 9.

Independent claims 13 and 17 are deemed to stand or fall together, separately from all of the other claims on appeal in the application, and particularly separately from independent claims 1, 7, 10, 14, and 18. Claims 13 and 17 are respectively apparatus and method claims directed in part to the storage of a plurality of different sound bites, different ones of which are accessed on successive occasions. None of the other independent claims on appeal in this application recite means of methodology related to such a storage.

Independent claim 18 is deemed to stand or fall separately from all of the other claims on appeal in the application, and particularly separately from independent claims 1, 7, 10, 13, 14 and 17. None of the other claims on appeal in this application recite a memory storing a signal corresponding to a predetermined sound substantially different from sound generated in nature upon placement of a sea shell next to an ear of a user.

Further reasons for the above groupings will be apparent from the differing arguments for patentability given below.

8. ARGUMENT

A. Rejection of Independent Claims 1 and 14 Under 35 U.S.C. §103

Claims 1 and 14 stand rejected under as being unpatentable over U.S. Patent No. 5,216,516 to Saitoh.

Appellant respectfully traverses the rejection of independent claims 1 and 14 under § 103 and maintains that claims 1 and 14 distinguish the invention over the prior art and particularly over Saitoh.

As set forth in claim 1, a novelty or entertainment device comprises a housing in the form of a sea shell, a sound reproduction system mounted to the housing so as to remain hidden from casual visual inspection of the housing, and a switch mounted to the housing and operatively connected to the sound reproduction system for activating same after and only after a lifting of the housing to an ear of a user.

Nothing in the prior art relied on by the Examiner teaches or suggests a switch connected to a sound reproduction system in a housing for activating that system after and only after the housing is lifted to an ear of a user. This feature of the invention is especially useful for the carrying out novelty purpose of the present invention Hearing the sound of the ocean occurs only when a sea shell has been placed next to the ear of the user. The novelty of the present invention would be considerably diminished if a sound were heard prior to the usual time when the expected ocean sound is perceivable.

Saitoh discloses an animated toy bird which has an external stimulus sensor in the form of a pyroelectric sensor for detecting infrared rays radiated from a human body. "[W]hen a person goes past or approaches the toy bird, the pyroelectric sensor detects infrared rays emitted from him to cause the control circuit 45 to actuate the motor 29 and sound generating unit 43 for a predetermined period of time...." (Col. 4, lines 32-36.) Clearly, Saitoh teaches the activation

As set forth in independent claim 14, a novelty or entertainment method comprises providing a housing in the form of a sea shell and reproducing a predetermined sound, after and only after a removal of the housing from a stationary storage position towards an ear of a user, so that the reproduced sound may be perceived by the user.

In its normal use, the toy bird of Saitoh is not intended to be picked up, let alone placed near the ear of a user. Since the bird toy moves, it might even be dangerous to one ear to place the toy near an ear or an eye. The sound reproduction in the toy bird of Saitoh occurs while the toy is sitting still. The movement and the sound reproduction are triggered by the mere approach of a warm body (radiating infrared electromagnetic energy). Nothing in Saitoh teaches or suggests reproducing a predetermined sound after and only after a removal of the toy bird from a stationary storage position towards an ear of a user.

B. Rejection of Dependent Claim 15 Under 35 U.S.C. §103

Claim 15 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,216,516 to Saitoh.

Claim 15 is patentable over Saitoh for the reasons set forth above with reference to claim 14. However, even if Saitoh suggested reproducing a predetermined sound after and only after a removal of a housing from a stationary storage position towards an ear of a user, Saitoh would not suggest having the toy bird speak words or verbal sounds, as set forth specifically in claim 15.

C. Rejection of Independent Claims 7 and 10 Under 35 U.S.C. §103

Claims 7 and 10 stand rejected under as being unpatentable over U.S. Patent No. 5,216,516 to Saitoh.

Appellant respectfully traverses the rejection of independent claims 7 and 10 under § 103 and maintains that claims 7 and 10 distinguish the invention over the prior art and particularly over Saitoh.

As recited in claim 7, a novelty or entertainment method comprises providing a housing in the form of a sea shell and, in response to a removal of the housing from a stationary storage position towards an ear of a user, reproducing a predetermined sound so that the reproduced sound may be perceived by the user upon and only upon an approximation of a mouth of the housing to the ear of the user.

It would interfere with the novelty of applicant's method if a sound were to emanate from the sea shell prior to a proper approximation of the sea shell to the ear of the user. Saitoh does not teach or suggest the reproduction of sound so as to be perceived by the user upon and only upon an approximation of a mouth of a housing to the ear of the user. Instead, Saitoh teaches the generation of sound upon a mere approach of a user to a toy bird. Thus, if the user were to lift the toy bird, the sound reproduction would be commenced even before the hand of the user could contact the toy, and certainly before the toy would be proximate to the ear of a user.

As set forth in claim 10, a novelty or entertainment device comprises a housing in the

lifting of the housing to an ear of a user, the switch including means for selectively activating the sound reproduction system only after the housing has been placed proximate to the ear of the user.

Saitoh neither discloses nor suggests a switch including means for selectively activating the sound reproduction system only after the housing has been placed proximate to the ear of the user. Saitoh only teaches that a sound reproduction device is to be activated where a person is nearby.

D. Rejection of Dependent Claim 8 Under 35 U.S.C. §103

Claim 8 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,216,516 to Saitoh.

Claim 8 is patentable over Saitoh for the reasons set forth above with reference to claim

7. U[illegible]on if Saitoh suggested reproducing a predetermined sound after and only after an

the movement of the housing, as set forth specifically in claim 9. The bird and its stand remain stationary pursuant to the Saitoh disclosure. Sound reproduction commences upon approach of a person (or other appropriately dimensioned life form) .

F. Rejection of Independent Claims 13 and 17 Under 35 U.S.C. §103

Claims 13 and 17 stand rejected under as being unpatentable over U.S. Patent No. 5,216,516 to Saitoh in view of U.S. Patent No. 4,923,428 Curran.

Appellant respectfully traverses the rejection of independent claims 13 and 17 under § 103 and maintains that claims 13 and 17 distinguish the invention over the prior art and particularly over Saitoh.

As set forth in claim 13, a novelty or entertainment device comprises a housing in the form of a sea shell, a sound reproduction system mounted to the housing so as to remain hidden from casual visual inspection of the housing, and a switch mounted to the housing and operatively connected to the sound reproduction system for activating same in response to a lifting of the housing to an ear of a user. As recited in claim 13, the sound reproduction system includes a memory storing a plurality of different sound bites and means for accessing different ones of the sound bites on successive activations of the sound reproduction system by the switch.

Saitoh discloses a toy bird wherein the reproduced sound is an imitation of the natural sound of a real bird. Saitoh says nothing about having different bird sounds emanate from the same toy bird. In fact, Saitoh teaches that different sounds may be employed in *different* kinds of [illegible] of any one toy matches the kind of bird simulated by that toy.

activations of a sound reproduction system.

The teachings of Saitoh suggest that each type of bird has its own characteristic sound and that this same sound is produced whenever the particular type of bird "sings." The teachings of Curran as to reproducing different sounds from a humanoid doll cannot suggest, to one of ordinary skill in the art, modifying the toy bird of Saitoh to have a single toy bird sing different sounds. This would be contrary to the teachings and implications of Saitoh to the effect that each bird species has a single characteristic sound or song.

G. Rejection of Dependent Claim 6 Under 35 U.S.C. §103

Claim 6 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,216,516 to Saitoh in view of U.S. Patent No. 4,923,428 Curran.

Claim 6 is patentable over Saitoh for the reasons set forth above with reference to claim 1. Claim 6 is also patentable for reasons discussed above with reference to claim 13.

H. Rejection of Independent Claim 18 Under 35 U.S.C. §103

Claim 18 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,216,516 to Saitoh in view of U.S. Patent No. 4,923,428 Curran.

Appellant respectfully traverses the rejection of independent claim 18 under § 103 and maintains that claim 18 distinguishes the invention over the prior art and particularly over the combination of Saitoh and Curran.

As set forth in claim 18, a novelty or entertainment device comprises a housing in the form of a sea shell and a sound reproduction system mounted to the housing so as to remain

hidden from casual visual inspection of the housing. The sound reproduction system includes a memory storing a signal corresponding to a predetermined sound substantially different from sound generated in nature upon placement of a sea shell next to an ear. A switch mounted to the housing is operatively connected to the sound reproduction system for activating same in response to a lifting of the housing to an ear of a user.

Saitoh teaches that the sound to be reproduced matches or simulates the natural sound of the bird species on which the toy bird is modeled. One of ordinary skill in the art following the teachings of Saitoh, if induced in some way not available from the art of record, to place a sound reproduction system in a real or artificial sea shell, would have the sound reproduction system imitate the natural sound of a sea shell. Nothing in Saitoh suggests storing and reproducing a predetermined sound substantially different from sound generated in nature upon placement of a sea shell next to an ear. Curran does not alter this result. Curran discloses a human doll making human sounds. Curran could not suggest that a toy bird make non-bird sounds or that a sea shell make non-sea shell sounds.

9. CONCLUSION

In summary, Saitoh does not suggest appellant's invention as set forth in independent claims 1, 7, 10, or 14. The combination of Saitoh and Curran does not suggest appellant's invention as set forth in independent claims 13, 17, or 18.

[illegible] of claims 1-18 under 35 U.S.C. § 103 are

The correspondence address for this application has changed. A Change of Correspondence Address is enclosed herewith

Respectfully submitted,

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APPENDIX A

1. A novelty or entertainment device comprising:

a housing in the form of a sea shell;

a sound reproduction system mounted to said housing so as to remain hidden from casual visual inspection of said housing; and

a switch mounted to said housing and operatively connected to said sound reproduction system for activating same after and only after a lifting of said housing to an ear of a user.

2. The device defined in claim 1 wherein said switch is a gravity switch.

3. The device defined in claim 1 wherein said switch is connected to a proximity detector for sensing nearness of a surface to a mouth of said housing.

4. The device defined in claim 1 wherein said sea shell is in the form of a conch shell.

5. The device defined in claim 1 wherein said sound reproduction system includes a solid-state memory, a power source, and an electroacoustic transducer.

6. The device defined in claim 1 wherein said sound reproduction system includes a memory storing a plurality of different sound bites and means for accessing different ones of said sound bites on successive activations of said sound reproduction system by said switch.

7. A novelty or entertainment method comprising:

providing a housing in the form of a sea shell; and

in response to a removal of said housing from a stationary storage position towards an ear of a user, reproducing a predetermined sound so that the reproduced sound may be perceived by the user upon and only upon an approximation of a mouth of said housing to the ear of the user.

8. The method defined in claim 7 wherein the sound includes a verbal message.

9. The method defined in claim 7, further comprising automatically sensing a movement of said housing, the reproducing of said sound being induced upon the sensing of said movement.

10. A novelty or entertainment device comprising:

a housing in the form of a sea shell;

a sound reproduction system mounted to said housing so as to remain hidden from casual visual inspection of said housing; and

a switch mounted to said housing and operatively connected to said sound reproduction system for activating same in response to a lifting of said housing to an ear of a user, said switch includes means for selectively activating said sound reproduction system only after said housing has been placed proximate to the ear of the user.

11. The device defined in claim 10 wherein said switch includes a gravity switch.

12. The device defined in claim 10 wherein said switch is connected to a proximity detector for sensing nearness of a surface to a mouth of said housing.

13. A novelty or entertainment device comprising:

a housing in the form of a sea shell;

a sound reproduction system mounted to said housing so as to remain hidden from casual visual inspection of said housing; and

a switch mounted to said housing and operatively connected to said sound reproduction system for activating same in response to a lifting of said housing to an ear of a user,

said sound reproduction system including a memory storing a plurality of different sound bites and means for accessing different ones of said sound bites on successive activations of said sound reproduction system by said switch.

14. A novelty or entertainment method comprising:

providing a housing in the form of a sea shell; and

after and only after a removal of said housing from a stationary storage position towards an ear of a user, reproducing a predetermined sound so that the reproduced sound may be perceived by the user.

15. The method defined in claim 14 wherein the sound includes a verbal message.

16. The method defined in claim 14, further comprising automatically sensing a movement of said housing, the reproducing of said sound being induced upon the sensing of said movement.

17. A novelty or entertainment method comprising:

providing a housing in the form of a sea shell;

in response to a first removal of said housing from a stationary storage position towards an ear of a user, reproducing a first predetermined sound so that the reproduced sound may be perceived by the user; and

in response to a second removal of said housing from a stationary storage position towards an ear of a user, reproducing a second predetermined sound so that the reproduced second predetermined sound may be perceived by the user, said

d determined sound being substantially different from said first predetermined

18. A novelty or entertainment device comprising:

a housing in the form of a sea shell;

a sound reproduction system mounted to said housing so as to remain hidden from casual visual inspection of said housing, said sound reproduction system including a memory storing a signal corresponding to a predetermined sound substantially different from sound generated in nature upon placement of a sea shell next to an ear; and

a switch mounted to said housing and operatively connected to said sound reproduction system for activating same in response to a lifting of said housing to an ear of a user.